

REMARKS

Claims 1-3, 12, 13, 16-21, 34-35 and 41-43 were previously pending. These claims have been cancelled and replaced by new claims 47-59 which were suggested by the Examiner. Applicants thank the Examiner for providing claim language that addresses the rejections.

Applicant notes that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG), and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future. Support for the new claims may be found in the claims as originally filed and throughout the specification, for example at pages 8-9, bridging paragraph.

1. Claims 1, 3, 12, 13, 16-21, 34-35, and 41-43 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement;
2. Claims 13, 16-21, 34-35 and 41-42 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite;
3. Claims 3, 34, and 35 stand rejected under 35 U.S.C. §102 as allegedly being anticipated by Purchio et al.

These rejections are addressed in order below.

1. The enablement rejection is moot.

Claims 1, 3, 12, 13, 16-21, 34-35, and 41-43 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. In the Office Action the Examiner has provided suggested claim language for enabled claims. Applicants have incorporated this language into new claims 47-59. The rejection is now moot due to cancellation of the claims and Applicants respectfully submit that new claims 47-59 are enabled.

2. The indefiniteness rejection is moot.

Claims 1, 3, 12, 13, 16-21, 34-35, and 41-43 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The rejected claims have been cancelled. New claims 47-59 address the rejection by the Examiner. Accordingly the rejection is moot and Applicants respectfully submit that the new claims are definite.

3. The anticipation rejection is moot.

Claims 3, 34, and 35 stand rejected under 35 U.S.C. §102 as allegedly being anticipated. These claims have been cancelled rendering the rejection moot. Applicants have submitted additional product-by-process claims in the format suggested by the Examiner. Applicants respectfully submit that these product-by-process claims define a cell population that is novel over the two cited references, Purchio et al. and Thompson et al.

The claims are directed to populations of cells that are derived from Wharton's jelly by a process that uses adherent cell selection and a media that includes EGF and PDGF. Purchio does not teach use of adherent cell selection of the growth factors in the culture media. Therefore, the claimed process is novel over Purchio and the cell population produced by the claimed process is different than the cell population produced by Purchio as established in the Second Mitchell Declaration. The Examiner's attention is especially directed to paragraphs 6-11 of the Second Mitchell Declaration, which contain data detailing the differences in cell surface marker expression as well as morphology and differentiation potential between cells produced according to the methods of Purchio et al. and the methods of the present invention. Because the cell populations produced by the claims method steps are different, they are not anticipated by Purchio et al. Likewise, the claimed cell populations differ from Thompson with regard to derivation (Wharton's jelly as opposed to embryos), cell surface marker expression and morphology. The Examiner cannot focus on the characteristics listed in the claims and ignore all the other different properties described in the declarations. Applicants respectfully submit that the patentability of a composition depends on all of its properties – the properties are inseparable from the composition. See *In re Papesch*, 137 USPQ 43 (CCPA 1963). Applicants have demonstrated that the properties of the claimed cell populations (i.e., cell surface marker

expression, morphology, ability to differentiate) are distinct from prior art cell populations. Accordingly, Applicants request that the anticipation rejection be withdrawn.

CONCLUSION

Applicants believe that the claims are in condition for allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the applicant encourages the Examiner to call the undersigned collect at (608) 662-1277.

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/John Mitchell Jones/

John Mitchell Jones
Registration No. 44,174

CASIMIR JONES S.C.
2275 Deming Way, Suite 310
Middleton, WI 53562
608.662.1277